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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,994	07/17/2003	Anthony J. Izbicki		9995

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EXAMINER

SAVAGE, JASON L

ART UNIT PAPER NUMBER

1775

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,994

Applicant(s)

IZBICKI ET AL.

Examiner

Jason L. Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20050912</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 are, drawn to a metallurgical material, classified in class 428, subclass 615+.
- II. Claims 10-15 are, drawn to a circuit breaker, classified in class 337, subclass 14+.
- III. Claims 16-20 are, drawn to a method of utilizing a metallurgical material, classified in class 257, subclass 459+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as transistors and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions I-II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product as transistors.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II or III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Larry W. Miller on September 12, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (US 3,755,881).

White teaches a metallurgical material comprising a metal strip **48** having metal fabrication portions **46** and **50** edge welded to the metal strip **48** (col. 1, ln. 1-48 and figure 4).

Regarding the limitation that the edge welded components be fabrication pads, the edge welded portions **46** and **50** of White would meet the limitation of being a fabrication pad.

Regarding claims 2 and 8, White teaches the metal strip may be a composite material having at least two layers **48.2a** and **48.1a** of dissimilar metal bonded together (col. 9, ln. 19-43). White also teaches an alternate embodiment wherein a composite metal strip comprising at least two layers **46**, **48** and **50** of dissimilar metal bonded together having metal fabrication portions **112** and **114** edge welded to the composite strip (col. 9, ln. 43-67 and Figure 10).

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Regarding claim 3, the second embodiment of White would meet the claim limitations wherein the fabrication portions **112** and **114** are monometallic materials which are edge welded to the bimetallic composite strip.

Regarding claim 4, the thickness of the layers are substantially equal (Figure 11).

Regarding claim 5, the composite material is thermally active and is adapted to provide a predetermined deflection in response to temperature changes (col. 1, ln. 1-22).

Regarding claim 6, fabrication portions are welded onto opposing sides of the strip in both embodiments of White (figures 10 and 11).

Regarding claim 7, the fabrication portions of White could also be considered contact members and would be just as operable to make and electrical contact with a source of current such as is claimed.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hickling (US 4,682,141).

Hickling teaches a metallurgical material comprising an active metal strip **30** having a metal fabrication portion **32** edge welded thereto (col. 5, ln. 34-58 and figure 2).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mickelson et al. (US 5,864,266).

Mickelson teaches a metallurgical material comprising an active composite strip **36** having a metal fabrication portion **56** edge welded thereto (col. 5, ln. 3-23 and figure 7).

Claim Rejections - 35 USC § 102

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US 3,755,881).

White teaches what is set forth above however it is silent to some of the claim limitations.

Regarding claims 3 and 4, White teaches a metal strip comprising at least two layers **46**, **48** and **50** of dissimilar metal bonded together having monometallic metal fabrication portions **112** and **114** edge welded to the composite strip which serve as support material which reduces the amount of the more expensive layers **46**, **48** and **50** required (col. 9, ln. 43-67 and Figure 10). White also teaches that bimetal materials **46a**, **48a**, and **50a** may be used in forming the composite strip (col. 9, ln. 19-43 and Figure 10).

White is silent to edge welding fabrication portions of monometallic material edge to a composite bimetal materials. However, it would have been obvious to one of

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ordinary skill in the art to have used edge bonded some of the monometallic support materials **112** and **114** in the bimetal composite strip of White in order to form a bimetal composite at a lower cost.

Regarding claim 9, although White teaches that multiple layers of differing materials may be bonded together, it is silent to the composite strip material comprising at least three layers of dissimilar metal bonded together. However, it would have been obvious to one of ordinary skill in the art to recognize that if bimetal materials were suitable for use in the composite of White that trimetal materials could be employed in the composite as well with a reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Savage whose telephone number is 571-272-1542. The examiner can normally be reached on M-F 6:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Savage
9-30-05



JOHN J. ZIMMERMAN
PRIMARY EXAMINER